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MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC
12010 SUNSET HILLS ROAD
SUITE 900
RESTON, VA 20190

EXAMINER
BIENEMAN, CHARLES A

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _24 June 2003_ .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-61_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-61_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____ .

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

˙DETAILED ACTION

1.   This action is responsive to the following communication: Amendment filed on June 24,

2003.

2.   Claims 1-61 are pending. Claims 1, 6, 11, 14, and 61 are independent claims.

Response to Amendment

3.   Applicant is reminded that in order to avoid an abandonment of this application, the

drawings must be corrected in accordance with the instructions set forth in Paper No. 4, mailed

on March 24, 2003 ("the prior Office action"). The reply filed on June 24, 2003 is not fully

responsive to the prior Office action because of the following omission(s) or matter(s): applicant

did not file a proposed drawing correction or corrected drawings as required in paragraph 4 of

the prior Office action. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona*

fide, applicant is given until the expiration of the period for response to this Office action to

supply the omission or correction in order to avoid abandonment.

Claim Objections

4.   **Claims 34 and 56** are objected to because of the following informalities: there is no

article, *e.g.*, "a", preceding the word "combination". Appropriate correction is required.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

6.   **Claims 17-21 and 39-43** are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the enablement requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claims recite resolving a formula continuously, or with a continuous resolving module, but the specification does not explain how a formula would be resolved continuously. (See Specification, page 14, lines 22-23.) Moreover, one of ordinary skill in the art would have understood that it would have been physically impossible truly to resolve the formula continuously inasmuch as resolving the formula was inherently a discrete act. Thus, some explanation is needed in the specification as to what is meant by "continuously", and such explanation is lacking.

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8.   Claims **17-21 and 39-43** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims recite resolving a formula continuously, or with a continuous resolving module, but it would have been physically impossible truly to resolve the formula "continuously" under the plain and ordinary meaning of that word inasmuch as resolving the formula was inherently a discrete act.

Claim Rejections - 35 USC § 102

9.   The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10.   **Claims 1-2, 6-7, 11, 14, 22-26, 29-30, 33-35, 37-38, 44-48, 51-52, 55-57, and 59-60** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 5,987,480 to Donohue et al., issued November 16, 1999, filed July 25, 1996.

Regarding **independent claim 1**, Donohue et al. disclose a data storage mechanism that stores the main document with a formula that resolves to a reference to an insert document, the insert document including contents for the main document. (Donohue et al., col. 6, lines 10-13: "The web page templates 24 stored on the web server 10 are markup language documents containing a number of dynamic content tags 34 and flow directives 36 embedded therein.")

Further, Donohue et al. disclose a shared resource database, accessible by a plurality of clients of the system, that stores one or more insert documents that may be referenced within the main document. (Donohue et al., col. 7, lines 37-41: "In some embodiments, the data source 12 is a relational database and includes a database storing content to be inserted into the templates 24 and a database management system for creating database structures, declaring data relationships, and performing database operations.")

Further, Donohue et al. disclose a document destination module that opens the main document and extracts the formula inasmuch as Donohue et al. teach a template parsing function. (Donohue et al., col. 10, lines 49-55: "The contents of the selected template are then retrieved, step 56, either all at once or by loading sections of the template sequentially into a buffer. The template parsing function 18 then reads the contents of the template to locate the "@" control symbols, step 58, and identifies the character string surrounded by the control symbols as a dynamic tag, IF instruction or LOOP instruction, step 60.")

Further, Donohue et al. disclose a formula resolution module that resolves the formula to derive a value for the reference, a document retrieval module that uses the reference to retrieve the insert document, and a document insertion module that inserts the insert document into the main document in a document location point specified. (Donohue et al., col. 10, lines 60-65:

"For a dynamic tag, the template parser 18 calls the appropriate library function 22 to retrieve the value corresponding to the name in the tag from the container, step 62, and replace the dynamic tag, including the name and control symbols, with the value retrieved from the container, step 64.")

Regarding **independent claim 6**, Donohue et al. disclose storing a main document with a formula that resolves to a reference to an insert document, the insert document including contents for the main document. (Donohue et al., col. 6, lines 10-13, quoted above.)

Further, Donohue et al. disclose storing one or more insert documents that may be referenced within the main document. (Donohue et al., col. 7, lines 37-41, quoted above.)

Further, Donohue et al. disclose retrieving and opening the main document. (Donohue et al., col. 10, lines 49-51, quoted above.)

Further, Donohue et al. disclose resolving the formula to derive a value for the reference, using the reference to retrieve the insert document, and inserting the insert document into the main document in a document insertion point. (Donohue et al., col. 10, lines 60-65, quoted above.)

Regarding **independent claim 11**, the rejection of claim 6 above is fully incorporated herein.

Further, Donohue et al. disclose extracting the formula from the main document. Donohue et al., col. 10, lines 51-55, quoted above.)

Regarding **independent claim 14**, the rejection of claim 1 above is fully incorporated herein.

Further, Donohue et al. disclose a computer useable medium having computer readable

code embodied therein. (Donohue et al., col. 6, line 2 – col. 3, line 24.)

Regarding **dependent claims 2 and 7**, Donohue et al. teach a document identification

module and means that receives the reference and determines the name of the insert document to

be retrieved based on the reference inasmuch as Donohue et al. teaches retrieving "the value

corresponding to the name in the tag from the container." (Donohue et al., col. 10, lines 61-62.)

Regarding **dependent claims 22 and 44**, Donohue et al. teach the main document

referenced to a plurality of insert documents inasmuch as they teach filling a plurality of data

fields into one template. (Donohue et al., col. 7, lines 49-55.)

Regarding **dependent claims 23 and 45**, Donohue et al. teach the insert document

referenced to a plurality of main documents inasmuch as Donohue et al. teach a plurality of

templates that can reference an insert document. (Donohue et al., col. 7, lines 16-17.)

Regarding **dependent claims 24-25 and 46-47**, Donohue et al. teach storing the main

document and the insert document separately inasmuch as they teach storing templates on the

web server (Donohue et al., col. 7, lines 15-17) and insert documents in a data source that may be

on a different computer. (Donohue et al., col. 7, lines 36-38.) Note that the examiner does not

regard the clause beginning with the words "in order to" in each of these claims to further limit

the scope of the claim because the clause merely recites an effect of implementing the recited

method step or system element but do not further limit or define the step or element being

recited.

Regarding **dependent claims 26 and 48**, Donohue et al. teach storing the insert

document in a first database (Donohue et al., col. 7, lines 37-42) and also teach that the main

document is stored in a second database inasmuch as they teach storing templates on the web

server (Donohue et al., col. 7, lines 15-17) which comprises a database under the broadest

reasonable interpretation of the term "database."

Regarding **dependent claims 29 and 51**, Donohue et al. teach that the main document is

a non-HTML document inasmuch as they make clear that their invention has a scope broader

than HTML documents. (Donohue et al., col. 4, lines 5-8.)

Regarding **dependent claims 30 and 52**, Donohue et al. teach that the insert document is

a non-HTML document inasmuch as they teach insert documents comprising name/value pairs.

(Donohue et al., col. 7, lines 45-47.)

Regarding **dependent claims 33 and 55**, Donohue et al. teach resolving a formula to a

link, the link corresponding to one or more documents, wherein the link is used to identify and

retrieve one or more insert documents inasmuch as Donohue et al. teach dynamic tags that are

resolved to retrieve data to be inserted into a document. (Donohue et al., col. 7, line 64 – col. 8,

line 8.)

Regarding **dependent claims 34 and 56**, Donohue et al. teach that the formula

corresponds to a combination of one or more functions and one or more fields. (Donohue et al.,

col. 8, line 55 – col. 9, line 15.)

Regarding **dependent claims 35 and 57**, Donohue et al. teach the formula based on a

function that determines a date and generates a link for the determined date. (Donohue et al.,

col. 7, line 53.)

Regarding **dependent claims 37 and 59**, Donohue et al. teach receiving a request from a

user to open the main document. (Donohue et al., col. 7, lines 27-30.)

Regarding **dependent claims 38 and 60,** Donohue et al. teach that the reference is a link and the link is other than a formula inasmuch as the dynamic tags taught by Donohue et al. are equivalent to formulas and dynamic tags are resolved to links to data. (Donohue et al., col. 7, lines 49-58.)

Claim Rejections - 35 USC § 103

11.   **Claims 3, 8, 12, and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al. in view of U.S. Patent Number 6,226,648 B1 to Appleman et al. issued May 1, 2001, earliest effective filing date February 6, 1998.

Donohue et al. do not teach enabling a user to create the main document with the reference to the insert document and storing the main document with the reference separately from the insert document being referenced. However, Appleman et al. teach creation and uploading of HTML templates by a user (Appleman et al., col. 7, lines 51-54) wherein the templates contain references to included files, *i.e.,* insert documents. (Appleman et al., col. 8, lines 29-45.) Further, Appleman et al. would have motivated one of ordinary skill in the art to take this step inasmuch as they teach that their approach eliminates or reduces the need to hard code design elements in a web page, promoting greater "design and maintenance flexibility." (Appleman et al., col. 9, lines 22-41.) Therefore, it would have been obvious to one of ordinary skill in the art to have enabled a user to create the main document with the reference to the insert document and store the main document with the reference separately from the insert document being referenced.

12.   **Claims 4, 9, and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Donohue et al. and Appleman et al. and further in view of U.S. Patent Number 6,006,242 to

Poole et al., issued December 21, 1999, filed April 5, 1996.

Neither Donohue et al. nor Appleman et al. teaches enabling a user to define the formula

that resolves to the reference to the insert document to be included in the main document.

However, Poole et al. does teach such a limitation. (Poole et al., col. 5, lines 7-10: "Each of the

constituent portions of the document is associated with an entity reference which is selected by

the document developer, as is indicated at step 34.") Moreover, one of ordinary skill in the art

would have recognized that the user would have needed the ability to define the formula that

resolves to the reference to the insert document to be included in the main document in order to

ensure that the appropriate insert document was inserted. Therefore, it would have been obvious

to one of ordinary skill in the art to enable a user to define the formula that resolves to the

reference to the insert document to be included in the main document.

13.   **Claims 5, 10, 32, and 54** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Donohue et al. in view of World Wide Web Consortium, *HTML 3.2 Reference Specification,*

W3C Recommendation 14 January 1997, pages 1-7, found online on March 18, 2003 at

www.w3.org/TR/REC-html32 and Appleman et al.

Regarding **dependent claims 5 and 10**, Donohue et al. do not teach that the document

location point comprises a background in the main document. However, *HTML 3.2 Reference*

Specification teaches on page 6 that background is an attribute of HTML's <BODY> element,

and further teaches on page 7 that the background attribute can be used to specify a URL

(equivalent to a formula) "for an image that will be used to tile the document background."

Moreover, Appleman et al. would have provided motivation to one of ordinary skill in the art to make background a document location point because Appleman et al. teaches the benefits of being able to soft-code design elements (Appleman et al., col. 9, lines 22-41), and one of ordinary skill in the art would have recognized that background is a design element. Therefore, it would have been obvious to one of ordinary skill in the art to have the document location point comprise a background in the main document.

Regarding **dependent claims 32 and 54**, Donohue et al. that the main document includes a predefined portion (Donohue et al., col. 8, lines 25-38), but do not teach that the predefined portion may be specified to include an insert document representing a background for the main document. However, *HTML 3.2 Reference Specification* teaches on page 6 that background is an attribute of HTML's <BODY> element, and further teaches on page 7 that the background attribute can be used to specify a URL (equivalent to a formula) "for an image that will be used to tile the document background." Moreover, Appleman et al. would have provided motivation to one of ordinary skill in the art to make the predefined portion specified to include an insert document representing a background for the main document Appleman et al. teaches the benefits of being able to soft-code design elements (Appleman et al., col. 9, lines 22-41), and one of ordinary skill in the art would have recognized that background is a design element. Therefore, it would have been obvious to one of ordinary skill in the art to allow the predefined portion to be specified to include an insert document representing a background for the main document.

14.   **Claim 16** is rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al. in view of Poole et al.

Donohue et al. do not teach enabling a user to define the formula that resolves to the

reference to the insert document to be included in the main document. However, Poole et al.

does teach such a limitation. (Poole et al., col. 5, lines 7-10: "Each of the constituent portions of

the document is associated with an entity reference which is selected by the document developer,

as is indicated at step 34.") Moreover, one of ordinary skill in the art would have recognized that

the user would have needed the ability to define the formula that resolves to the reference to the

insert document to be included in the main document in order to ensure that the appropriate

insert document was inserted. Therefore, it would have been obvious to one of ordinary skill in

the art to enable a user to define the formula that resolves to the reference to the insert document

to be included in the main document.

15.   **Claims 17, 36, 39, 58, and 61** are rejected under 35 U.S.C. 103(a) as being unpatentable

over Donohue et al. in view of U.S. Patent Number 6,442,651 B2 to Crow et al., issued August

27, 2002, filed October 28, 1997.

Regarding **dependent claims 17 and 39**, Donohue et al. do not teach a continuous

resolving module that resolves the formula continuously. However, Crow et al. teach

periodically refreshing a cache equivalent to applicants' recitation of continuously resolving a

formula including objects, *i.e.*, insert documents, embedded in web pages. (Crow et al., col. 4,

lines 52-55.) Moreover, one of ordinary skill in the art would have recognized the benefit of

having the most up-to-date data possible. Therefore, it would have been obvious to one of

ordinary skill in the art to resolve the formula continuously.

Regarding **dependent claims 36 and 58**, Donohue et al. does not teach continuously

resolving the link to a field representing an image for the main document. However, Crow et al.

teach periodically refreshing a cache equivalent to applicants' recitation of continuously

resolving a formula including objects, *i.e.*, insert documents, embedded in web pages. (Crow et

al., col. 3, lines 53-54, col. 4, lines 52-55.) Moreover, one of ordinary skill in the art would have

recognized the benefit of having the most up-to-date data, including the most up-to-date images,

possible. Therefore, it would have been obvious to one of ordinary skill in the art to

continuously resolve the link to a field representing an image for the main document.

Regarding **independent claim 61**, Donohue et al. teach enabling a user to open the main

document (Donohue et al., col. 7, lines 27-30), the main document stored in a first database

including a formula to one or more insert documents stored in a second database (Donohue et al.,

col. 8, lines 10-13.)

Further, Donohue et al. teach resolving the formula in order to identify at least one

corresponding insert document, the insert document including contents for the main document.

(Donohue et al., col. 6, lines 10-13: "The web page templates 24 stored on the web server 10 are

markup language documents containing a number of dynamic content tags 34 and flow directives

36 embedded therein.")

Further, Donohue et al. teach retrieving the identified insert document from the second

database. (Donohue et al., col. 9, lines 16-17.)

Further, Donohue et al. teach inserting the identified insert document into the main

document at a predetermined document location point. (Donohue et al., col. 10, lines 60-65:

"For a dynamic tag, the template parser 18 calls the appropriate library function 22 to retrieve the

value corresponding to the name in the tag from the container, step 62, and replace the dynamic

tag, including the name and control symbols, with the value retrieved from the container, step 64.")

Further, Donohue et al. do not teach resolving the formula continuously. However, Crow et al. teach periodically refreshing a cache equivalent to applicants' recitation of continuously resolving a formula including objects, *i.e.*, insert documents, embedded in web pages. (Crow et al., col. 4, lines 52-55.) Moreover, one of ordinary skill in the art would have recognized the benefit of having the most up-to-date data possible. Therefore, it would have been obvious to one of ordinary skill in the art to resolve the formula continuously. Note that the examiner does not regard the clauses beginning with the words "in order to" in this claim to further limit the scope of the claim because the clauses merely recite an effect of implementing the recited method step element but do not further limit or define the step or element being recited.

16.   **Claims 27-28, 31, 49-50, and 53** are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue et al. in view of Cate Richards, *Using Lotus Notes 4.5* (Que: 1997), page 9.

Regarding **dependent claims 27-28 and 49-50**, Donohue et al. do not teach that either the first database or the second database is a Lotus Notes database. However, Richards would have provided motivation for one of ordinary skill in the art to make the first and second databases Lotus Notes databases inasmuch as Richards teaches on page 9 that Lotus Notes databases were easy to develop. Therefore, it would have been obvious to one of ordinary skill in the art to make the first database and the second database Lotus Notes databases.

Regarding **dependent claims 31 and 53**, Donohue et al. inherently teach that the insert document stored in the first database can be modified to a modified insert document, wherein the

modified insert document is inserted into the main document in response to the user selecting the main document inasmuch as Donohue et al. teaches storing inserts documents in a database as noted above regarding claims 26 and 48 and thus the insert documents taught by Donohue et al. inherently could have been modified to a modified insert document, wherein the modified insert document is inserted into the main document in response to the user selecting the main document.

Response to Arguments

17.   Applicant's arguments filed June 24, 2003 have been fully considered but they are not persuasive.   Applicants' arguments boil down to the contention that Donohue et al. do not teach an "insert document including contents for the main document" as recited in claim 1. (Remarks, page 12, lines 24-25.) First, the examiner does not believe that the addition of this limitation narrows or changes the claim's scope, inasmuch as the claim recites inserting an insert document into the main document, and therefore an insert document clearly "includes contents for the main document" even without the explicit recitation of this limitation. Moreover, the specification broadly defines "insert document", stating that the term "should be understood to include data that may be inserted into a main document." (Specification, page 7, lines 4-5.) As noted above in the rejection of claim 1, Donohue et al. teach retrieving data that is inserted into a main document, and the examiner believes that this data falls within the definition of "insert document" given in the specification. Note that the data taught by Donohue et al. inherently includes contents for the main document inasmuch as the data is inserted into the main document.

Conclusion

18.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

U.S. Patent Number	Name	Issue Date	File Date	
6,598,094 B1	Wollrath et al.	7/22/03	3/20/98	
6,574,674 B1	May et al.	6/3/03	5/24/96	
6,573,911 B2	Brockbank	6/3/03	7/21/98	
6,331,864 B1	Coco et al.	12/18/01	9/23/97	
5,990,931	Nimri et al.	11/23/99	4/9/97	
5,889,945	Porter et al.	3/30/99	12/27/95	
5,805,886	Skarbo et al.	9/8/98	12/19/96	

19.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this
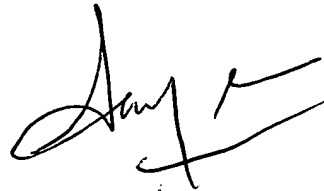
final action.

20.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Charles A. Bieneman whose telephone number is 703-305-8045.

The examiner can normally be reached on Monday - Thursday, 6:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph H. Feild can be reached on 703-305-9792. The fax phone number for the

organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is 703-305-4700.

CAB

SANJIV SHAH
PRIMARY EXAMINER